

## REMARKS

In this Response, claims 1, 6, and 34 have been amended. Support for these amendments is found throughout the originally filed specification. No new matter has been added.

Claims 1 – 10, 34, and 40 – 43 are presently pending.

### Specification

In item 3 on pages 2 and 3 of the Office Action it is noted that the Summary of the Invention section is missing. Applicants would like to point out that neither MPEP 608.01(d) nor 37 CFR 1.73 requires that Applicants include a Summary of the Invention.

37 CFR 1.73 states: "A brief summary of the invention indicating its nature and substance, which may include a statement of the object of the invention, *should* precede the detailed description. Such a summary should, *when set forth*, be commensurate with the invention as claimed and any objects recited should be that of the invention as claimed" (emphasis added).

Thus, as can be seen, 37 CFR 1.73 simply details the requisite contents of the Summary and its placement when it is set forth. It does not, however, require that it be set forth. Language commonly used in law and regulation to indicate a requirement, such as "must," is absent from 1.73. See, e.g., 37 CFR 1.71 providing the "specification *must* include a written description"; or 37 CFR 1.75 providing the "specification *must* conclude with a claim ..." (emphasis added). Thus, it is clear that language such as "must," not "should," is used when setting forth the requirements for the content of the Specification.

Further, if one interprets "should" as "must," the clause "when set forth" becomes a meaningless superfluity, as the Summary would always be set forth under such an interpretation.

Because of the absolute lack of “must” language in 1.73, it follows that a Summary of the Invention is NOT required. Accordingly, Applicants have not amended the Specification to add such a Summary.

### 35 U.S.C. §112 Rejections

In the Office Action claims 1, 6, and 34 are rejected under 35 U.S.C. 112, first and second paragraphs, for failing to comply with the written description requirement and being indefinite. In particular, the Examiner states that there is no explicit teaching in the specification of “a media message including a first reference” and it cannot be determined what functional limitation is provided by the element “first reference is given effect.”

While the Applicants believe that a person skilled in the relevant arts would have a clear understanding of the support and meaning of these elements in light of the specification, as detailed in the Applicants’ response filed on February 27, 2007, the Applicants have presented amendments to further clarify the nature of the limitation. As amended, claim 1 now recites that the media message includes a link that, when dereferenced, results in the logic testing digital content capabilities of the receiving computing system.

Support for the link being included in the message and dereferenced is found at least in paragraphs [0025] and [0037]. For example, “[t]he IP message contains a traversable link to a layer selector for browser-based viewing of the adaptive media message, as well as an inclusion link for test and replace scripts that support email message-based viewing of the adaptive media package... In step **804**, the inclusion link is dereferenced to load and execute scripts...” Paragraph [0035]. The traversable link may be dereferenced by being traversed by a recipient. “Dereferencing,” as would be understood by a person skilled in the art in light of the specification, may refer to the accessing of the logic (e.g., scripts) referred to by the link. This is consistent with commonly understood definitions of dereferencing in the computer sciences.

### 35 U.S.C. §103 Rejections

Claims 1-10, 23, 34, 40, and 41 are rejected as being unpatentable over Sahai et al., U.S. Patent No. 6,594,699 (hereinafter "Sahai") in view of Hill et al., U.S. Patent No. 6,023,714 (hereinafter "Hill").

Claim 1, as amended, recites instructions that cause a processor to generate and transmit one or more messages to a receiving computer system, the one or more messages including

- a media message to be displayed on the receiving computer system as a first layer of an adaptive media message, the media message including a link;
- logic for testing digital content capabilities of the receiving computer system when the link is dereferenced; and
- logic for displaying a selected one of a plurality of versions of digital content selected based on the results of testing digital content capabilities of the receiving computer system, such that the receiving computer system may display the selected version of the digital content in the media message as a second layer of the adaptive media message.

As can be seen, claim 1 clearly recites that the one or more messages include a media message to be displayed on the receiving computer system as a first layer of an adaptive media message. The media message will also have a link that, when dereferenced, results in the receiving computer system's capabilities being tested and an appropriate version of digital content being selected and displayed in the media message as a second layer of the adaptive media message. So, while the test and select logic is being executed, the user may be able to view the media message displayed on the receiving computer system as the first layer of the adaptive media message, which may be designed to be easily viewed on most receiving computer systems. If the test and select logic determines this particular receiving computer system is capable of displaying a more advanced layer of the adaptive media message, the second layer may be constructed and displayed as recited in claim 1.

Sahai, on the other hand, teaches that a server determines capabilities of the client and transcodes a web page, requested by the client, prior to delivery to the client. Accordingly, there is only one version of the web page that ever gets delivered for display on the client device.

Hill, which was relied upon to teach “the first reference being given effect,” fails to correct for the above-identified shortcoming of Sahai. Hill teaches an HTML document having a layout generator script being sent to a client. The script may execute on the client device and determine which one of a number of different style sheets would present the content of the HTML document in the best manner given the capabilities of the client. The script may then obtain the selected style sheet and the HTML document may be displayed with the formatting provided by the selected style sheet. So, Hill, similar to Sahai, expressly teaches that only one version of the message will be displayed.

Claims 2 – 10, 23, 34, 40, and 41 depend from, or include limitations similar to, claim 1 and are patentably distinct from the combination of Sahai and Hill for at least the reasons given above. Therefore, the Applicants respectfully request that the Examiner withdraw these rejections of these claims.

Claims 42 and 43 are rejected as being unpatentable over Sahai, Hill and further in view of Li et al., U.S. Patent No. 6,345,279 (hereinafter “Li”).

Claims 42 and 43 depend, directly or indirectly, on claim 34. As discussed above, the combination of Sahai and Hill fail to make claim 34 obvious. Li fails to correct for the underlying deficiencies of the Sahai/Hill combination.

Li discusses a system that is similar to Sahai but further details the transcoding operation. Specifically, Li teaches taking a web document and generating different versions (including both modality (e.g., video v. text) and resolution) of each of the elements. Then, the web document will be adapted with the appropriate version of each element based on received capabilities of the client. The adapted web document will be sent to the client. So, similar to Sahai, Li explicitly teaches that only one version of the web document will ever be delivered to the client device for display.

For at least these reasons, claims 42 and 43 are patentable over the asserted combination of Sahai, Hill, and Li. Therefore, the Applicants respectfully request that the Examiner withdraw these rejections of these claims.

Conclusion

For the above reasons, the Applicants respectfully assert that all of the pending claims are patentable and request that the Examiner allow these claims as presented. If the Examiner has any questions, he is invited to contact the undersigned at (503) 796-2972.

The Commissioner is hereby authorized to charge shortages or credit overpayments to Deposit Account No. 500393.

Respectfully submitted,  
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Dated: 08/21/2007

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